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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/259,619	03/01/1999	TIMOTHY LABADIE	210655.90018	5502
26710	7590	10/18/2006	EXAMINER	
QUARLES & BRADY LLP 411 E. WISCONSIN AVENUE SUITE 2040 MILWAUKEE, WI 53202-4497				COLBERT, ELLA
		ART UNIT		PAPER NUMBER
		3694		

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary for Applications Under Accelerated Examination</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/259,619	LABADIE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Ella Colbert	3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Since this application has been granted special status under the accelerated examination program,

**NO extensions of time under 37 CFR 1.136(a) will be permitted and a SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE:**

ONE MONTH OR THIRTY (30) DAYS, WHICHEVER IS LONGER,  
FROM THE MAILING DATE OF THIS COMMUNICATION – if this is a non-final action or a Quayle action.  
(Examiner: For FINAL actions, please use PTOL-326.)

The objective of the accelerated examination program is to complete the examination of an application within twelve months from the filing date of the application. Any reply must be filed electronically via EFS-Web so that the papers will be expeditiously processed and considered. If the reply is not filed electronically via EFS-Web, the final disposition of the application may occur later than twelve months from the filing of the application.

#### Status

- 1) Responsive to communication(s) filed on 01 August 2006.
- 2) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 3) Claim(s) 1-4,8-11,13,14,16 and 17 is/are pending in the application.
  - 3a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 4) Claim(s) \_\_\_\_\_ is/are allowed.
- 5) Claim(s) 1-4,8-11,13,14,16 and 17 is/are rejected.
- 6) Claim(s) \_\_\_\_\_ is/are objected to.
- 7) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 8) The specification is objected to by the Examiner.
- 9) The drawing(s) filed on 01 August 2006 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 10) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 11) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____.                                     |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____.   | 6) <input type="checkbox"/> Other: _____.                         |

**DETAILED ACTION**

1. Claims 1-4, 8-11, 13, 14, and 16-17 are pending. Claims 1 and 3 have been amended and claim 17 has been newly added in this communication filed 08/01/06 entered as Response After Non-Final Action, New or Additional Drawings, and Substitute Specification.
2. The Substitute Specification has been reviewed and entered.
3. The drawings have been reviewed and entered.
4. Applicants' claim objection to claim 1 is hereby withdrawn in view of Applicants' convincing argument.
5. The 35 U.S.C. 112 second paragraph rejection because of "a probability of a payment obligation by the customer being honored" appearing out of place has been overcome by Applicants' amendment to claim 1 and is hereby withdrawn.
6. Claims 1, 2, 9-11, 13, and 14 still remain rejected under 35 USC 112 second paragraph based on the limitations "unique customer identifier" and "customer identifier". See "Response to Arguments" section of this Office Action.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
8. Claims 1, 2, 9-11, 13, and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, lines 11-19 recite "... the processor computer further including a data structure matching the customer identifier to at least one statistical element indicating a probability of a payment obligation by the customer being honored ...; wherein an ... to the merchant computer ... ". The following limitation to this claim appears to be out of place in connecting the remainder of the claim limitation: "..., a probability of a payment obligation by the customer being honored without communication with the third party bank". Then the next claim limitation goes on to recite "wherein an authorization indication based on the statistical element is transmitted to the merchant computer, the authorization indicating whether check payment for the product should be accepted and upon the authorization indication indicating that the check payment should be accepted ...". It is unclear from the claim language where the authorization indication is coming from.

Claims 2, 9 and 13 recite "unique customer identifier".

Claims 2, 10,11, and 14 recite "customer identifier".

Thus, it is unclear whether there is a "unique customer identifier" and a "customer identifier". If there is only one "customer identifier" the claim language needs to be amended to recite either "customer identifier" or "unique customer identifier".

Claim 1 recites the limitation "unique customer identifier". Claim 2, line 4 recites "unique customer identifier" and line 5 recites "customer identifier". It is still unclear from the Specification and the claim language what the difference is in "unique customer identifier" and "customer identifier".

**Suggested Claim Amendments**

9. It is suggested to add and to clarify in the claim language “the statistical elements are not security related”. The “authorization” element in claim limitation three is considered to be a security feature. It is unclear to the Examiner how the matching of the customer identifier takes place to a selection of the check payment option then the data structure matching the customer identifier to at least one statistical element without the communication with the third party bank. Why is the “statistical element” not considered a security feature”? What is this a “statistical element”? The third limitation needs to be more clearly written because as written it is very unclear. It is suggested to break part of the limitation apart like limitations one, two, and four. Also to add “Internet check payment” in the body of the claim.

Applicant might consider adding some claim language relating to the merchant needing a statistical understanding of the risks of accepting a check from the customer in order to have an understanding this takes place. It is unclear as to the “statistical elements” that indicate probability of a payment obligation by the customer being honored. Clarification in the claim language is respectfully requested.

**Allowable Subject Matter**

10. Claim 1 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

11. Claims 9-11 and 13-14 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

12. Claims 2-4, 8-11, 13, 14, 16, and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
13. The following is a statement of reasons for the indication of allowable subject matter: "a processor computer independent from the customer computer and the merchant computer programmed to receive at least one customer identifier in response to a selection of the payment by check option, the processor computer further including a data structure matching the customer identifier to at least one statistical element without communication with the third party bank and based on that matching statistical element transmitting to the merchant computer an authorization indication indicating whether check payment for the product should be accepted" in independent claim 1 is allowable over the prior art of record.

***Response to Arguments***

14. Applicant's arguments filed 08/01/06 have been fully considered but they are not persuasive.

Issue no. 1: Applicants' argue: Claims 1, 2, 9-11, 13, and 14 were rejected based on the limitations "unique customer identifier" and "customer identifier" and "unique customer identifier" is a different claim limitation than "customer identifier". The Examiner is directed to see paragraphs [0007], [0014], and [0031] of the Applicants' Specification. Also claim 2 being rejected because of "unique customer identifier" and "customer identifier" lacking antecedent basis and Applicants' contend that proper

antecedent basis for both terms is provided in claim 1 from which claim 2 depends.

These arguments have been considered but are not persuasive.

Response: It is still unclear from Applicants' Specification paragraphs [007], [0014], and [0031] the difference between "unique customer identifier" and "customer identifier". Another issue, in particular, with claim 1 is "unique customer identifier" is only recited in claim limitation two and not in any of the other claim limitations. "The "unique customer identifier" should be in another of the claim limitations because it is unclear in the claim language what is being done with "unique customer identifier" once it is transmitted from the customer over the Internet. Clarification is respectfully requested to in the claim limitations. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Applicants' have not addressed number 8 on page 6 and numbers 8-12 on pages 7 and 8 of the Office Action dated April 29, 2006. These are the reasons for the final rejection.

If Applicants' consider filing a "Request for Continued Examination" if an advisory should result from this communication, it is suggested Applicants' add method claims with similar allowable subject matter and claim limitations similar to the claim limitation of claims 1-4, 8-11, 13, 14, 16, and 17 in order to better protect their invention.

### ***Conclusion***

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**Inquiries**

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

October 16, 2006



ELLA COLBERT  
PRIMARY EXAMINER